

REMARKS/ARGUMENTS

Status of the Claims

With entry of this amendment, claims 1, 16 and 20 have been amended and claims 2 and 18 have been canceled such that claims 1, 3-17, 19 and 20 are currently pending in the application. No new matter has been added by this amendment. Reconsideration of this Application and entry of this Amendment are respectfully requested.

35 U.S.C. § 102 and 35 U.S.C. § 103 Rejections in View of Douk

Claims 1-9, and 11-20 stand rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 6,911,036 to Douk *et al.*, hereinafter “Douk.” Applicants traverse the rejections under §102 because Douk fails to teach all elements of the claims. Applicants traverse the rejections under §103 because the Examiner has not demonstrated all the elements of a *prima facie* case of obviousness.

Claim 1 is novel over Douk because Douk fails to teach

a core wire including a tapered undulating section carried within the hollow guidewire and providing greater friction when the core wire translates in a first direction within the hollow guidewire than when the core wire translates in a second direction within the hollow guidewire

as now required by claim 1, in part. Douk’s undulating core wire section is not tapered, and nowhere does Douk teach providing greater friction when the core wire translates in a first direction within the hollow guidewire than when the core wire translates in a second direction within the hollow guidewire. Thus, the rejection of claim 1 is improper because Douk fails to teach all the elements of claim 1, as required for anticipation under 35 U.S.C. § 102.

In paragraph 3 of the Detailed Action, the Examiner has alleged that “it would have been an obvious design choice to one of ordinary skill in the art to use tapered undulating section . . . to replace the constanced undulating section as described by Douk *et al.* since such a design does

not provide any advantage over Douk's design." The Examiner has also analyzed the frictional forces associated with core wire undulations, concluding that the resulting force generated by the tapered undulating section "will be the sum of frictional forces generated by each undulation," and "can be achieved by Douk's design with a routine experiment."

Applicants dispute the Examiner's allegation that the claimed invention does not provide any advantage over Douk's design. Douk fails to teach the problem addressed by the instant invention, namely to provide improved frictional control between a core wire and a hollow guidewire wherein there is greater friction when the core wire translates in a first direction within the hollow guidewire than when the core wire translates in a second direction within the hollow guidewire. Applicants also respectfully disagree with the Examiner's mechanical analysis of frictional forces associated with tapered core wire undulations inasmuch as the Examiner has overlooked the difference in friction forces that occur when the core wire moves in opposite directions within the hollow guidewire. Applicants contend that the Examiner's *prima facie* conclusion of obviousness is defective under 35 U.S.C. § 103 because "obvious-to-try" is not the test of obviousness and because there is no suggestion or motivation, either in Douk itself or in the knowledge generally available to one of ordinary skill in the art, to modify Douk to solve the problem addressed by the current invention (MPEP 2142). Therefore, the rejection of claim 1 under 35 U.S.C. § 103 is improper.

Claim 2 has been canceled, rendering rejections of this claim moot. Claims 3-9, and 11-15 depend directly or independently from claim 1 and are patentable under both 35 U.S.C. §§ 102 and 103 for the same reasons discussed above regarding claim 1.

Claim 16 is novel over Douk because Douk fails to teach

providing a core wire inserted through a hollow guidewire, the core wire including a tapered undulating section carried within the hollow guidewire, . . . and wherein the tapered undulating section provides a different amount of friction when the core wire translates in the first direction than when the core wire translates in the second direction

as required by claim 16, in part. Douk's undulating core wire section is not tapered, and nowhere does Douk teach the tapered undulating section providing a different amount of friction when the core wire translates in the first direction than when the core wire translates in the second direction. Thus, the rejection of claim 16 is improper because Douk fails to teach all the elements of claim 16, as required for anticipation under 35 U.S.C. § 102. Applicants find no Examiner's argument regarding obviousness of claims 16, 17 and 19 under 35 U.S.C. § 103.

Claim 18 has been canceled, rendering rejections of this claim moot. Claims 17 and 19 depend directly or independently from claim 16 and are patentable under 35 U.S.C. § 102 for the same reasons discussed above regarding claim 16.

Claim 20 is novel over Douk because Douk fails to teach

the core wire including frictional control means disposed within the hollow guidewire for providing a different amount of friction based on a translational direction of the core wire within the hollow guidewire

as required by claim 20, in part. Douk's frictional control means does not provide a different amount of friction based on a translational direction of the core wire within the hollow guidewire. Applicants find no Examiner's argument regarding obviousness of claim 20 under 35 U.S.C. § 103.

35 U.S.C. § 103 Rejection Over Douk in View of Dubrul

Claim 10 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Douk in view of U.S. Pub. No. 2004/0236369 A1 to Dubrul. Applicants traverse the rejection under §103 because the Examiner has not demonstrated all the elements of a prima facie case of obviousness. In particular, claim 10 depends indirectly from claim 1, which includes, in part, the following limitations that are not taught by Dubrul and Douk, either alone or in combination.

a core wire including a tapered undulating section carried within the hollow guidewire and providing greater friction when the core wire translates in a first direction within the hollow guidewire than when the core wire translates in a second direction within the hollow guidewire.

The prima facie conclusion of obviousness is defective under 35 U.S.C. § 103 because the combination of Dubrul and Douk fails to teach the claim as a whole.

In view of the above arguments, applicants request that all outstanding rejections be withdrawn.

Conclusion

For the foregoing reasons, Applicants believe all the pending claims are in condition for allowance and should be passed to issue. The Commissioner is hereby authorized to charge any additional fees which may be required under 37 C.F.R. 1.17, or credit any overpayment, to Deposit Account No. 01-2525. If the Examiner feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned at telephone (978) 739-3075 (Eastern Time).

Respectfully submitted,

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